

**REMARKS**

Claims 1-13, 15, 17, 19 and 21-34 have been examined on their merits.

The Examiner indicates that claims 2, 4-7, 9, 11, 13, 15, 17 and 19 are withdrawn from consideration.

Applicant herein amends claims 33 and 34 to correct typographical errors, and to clarify the type of charge accumulated on the semiconductor integrated circuit device. The amendments to claims 33 and 34 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 33 and 34 were not made for reasons of patentability.

Claims 1-13, 15, 17, 19 and 21-34 are all the claims presently pending in the application.

1. Claims 33 and 34 stand rejected under 35 U.S.C. § 112 (2<sup>nd</sup> para.) as being indefinite. Applicant traverses the rejection of claims 33 and 34 for at least the reasons discussed below.

The Examiner states that it is “unclear what is meant by a charge device model, ..., it is unclear what is meant by charge stored according to a charge device model, where the charge is stored and what is a charge device model.” *See* December 10, 2003 Non-Final Office Action, pg. 2. The written disclosure of the instant application at pages 1-8 discusses at least three models for explaining the generation of electrostatic charge breakdown.<sup>1</sup> The cited pages

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<sup>1</sup> The human-body model (HBM), the machine model (MM) and the charged device model (CDM).

describe the charged device model and reference publications and Japanese patent applications that disclose how the charged device model is utilized. In the Office Action, there is no explanation as to why one of ordinary skill in the art would not understand the charged device model described at pages 1-8 of the instant written disclosure. It is well settled that patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). Thus, Applicant respectfully requests that the Examiner withdraw the § 112 (2<sup>nd</sup> para.) rejection of claims 33 and 34.

2. Claims 1, 3, 8, 10, 12, 21-23 and 25-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya (JP Heisei 11-154733). Applicant traverses the rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-34, and insofar as the rejection applies to new claims 33 and 34, for at least the reasons set forth below.

Applicant has overcome the Examiner's previous arguments with respect to Ozaki et al. (U.S. Patent No. 4,456,939), Miller (U.S. Patent No. 5,255,146), Cohn et al. (U.S. Patent No. 5,535,134), Puar (U.S. Patent No. 4,786,956) and Igarashi (U.S. Patent No. 4,656,491).

Furuya discloses, *inter alia*, a capacitor (613) coupled between a V<sub>DD</sub> wire (605) and a V<sub>SS</sub> wire (604). A MOS device (609) is connected in parallel with the capacitor (613). See Figure 6 of Furuya.

Furuya fails to teach or suggest that the wire resistance of a ground wire portion between an electrostatic protection element and a ground terminal is larger than a wire resistance of the ground wire portion between the electrostatic protection element and a MOS capacitor, as recited

in independent claims 1, 21, 33 and 34. In Figure 6 of Furuya, there is no indication that the MOS device (609) is positioned relative to a capacitor (613) such that the resistive relationship as recited in claim 1 is taught or suggested. The Examiner asserts that Figure 6 of Furuya shows the claimed resistive relationship based on the positioning of the MOS device (609) along a ground wire relative to the capacitor (613) and a ground terminal (606). Figure 6 of Furuya cannot, however, support an obviousness rejection. “When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP § 2125. “[I]t is well established that patent drawings do not define the precise proportions of the elements and **may not be relied** on to show particular sizes if the specification is completely silent on the issue.” MPEP § 2125 *quoting Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (*emphasis added*). “Absent any written description in the specification on quantitative values, arguments based on measurement of a drawing are of little value.” *In re Wright*, 193 U.S.P.Q. 332, 335 (C.C.P.A 1977).

The Examiner states that Figure 6 of Furuya shows that the “wire resistance of the ground potential between the ESD element connection point and the ground terminal 606 is larger than that between the ESD element connection point and the capacitor’s connection point, because a wire resistance is directly proportional to the length of the wire, and the **distance between the ESD element connection point and the ground terminal 606 is larger than that between the ESD element connection point and the capacitor’s connection point.**” *See* December 10, 2003 Non-Final Office Action, pg. 3 (*emphasis added*). Although the Examiner claims that he is

not relying “on figure 6 of Furuya to teach the precise proportions of the elements,” the above emphasized quotation from the December 10, 2003 Non-Final Office Action makes it very clear that the Examiner **is relying** on Figure 6 of Furuya as allegedly supplying the necessary teaching for the claimed resistive relationship. *Hockerson-Halberstad* and *Wright* require the Examiner to support his distance allegations with citations from Furuya’s underlying text document regarding the distances between the component connections illustrated in Figure 6 of Furuya. However, since the Examiner has failed to obtain a translation of Furuya, the potential avenue of support afforded by *Hockerson-Halberstad* and *Wright* is foreclosed. Without the requisite translation of Furuya, the Examiner is *without* a description of quantitative values that would support the § 103(a) rejection based on Figure 6 of Furuya. *See Wright*, 193 U.S.P.Q. at 335.<sup>2</sup>

In the Response to Arguments section of the December 10, 2003 Non-Final Office Action, the Examiner claims that *Wright* stands for the proposition that the drawings of Furuya, along with the description of the article, can be reasonably relied upon for what they would teach one of ordinary skill in the art. Applicant’s undersigned representative cannot find any language

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<sup>2</sup> The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the U.S. Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The U.S. Patent and Trademark Office is required to apply the law “in accordance with statute and precedent.” *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Patent Office is obligated under the Administrative Procedures Act to develop an evidentiary basis for its findings. *Id.* at 1434. As discussed *supra*, without a translation of the underlying text document of Furuya, the Examiner cannot use Figure 6 to reject independent claims 1, 21, 33 and 34. Moreover, the burden is on the Examiner to make the *prima facie* case of obviousness, and the record must be complete. *See* MPEP § 706.02. In the instant application, the record is incomplete since no translation of Furuya has been obtained, and it is not Applicant’s burden to obtain the translation. *See* MPEP § 706.02. Without a translation of the underlying text document of Furuya, the Examiner has no objective support for the rejection of independent claims 1, 21, 33 and 34.

in *Wright* that reasonably supports the Examiner's interpretation, and requests that the Examiner provide a copy of the language that supports such an interpretation in the next Communication from the Patent Office. Notwithstanding the lack of support for the Examiner's interpretation of *Wright*, the Examiner lacks an English language translation of Furuya, so there can be no reliance on "the description" of Furuya.

*In re Olson*, 101 U.S.P.Q. 401 (C.C.P.A 1954) directly contravenes the Examiner's argument with respect to Figure 6 of Furuya as well. In *Olson*, a putative patentee attempted to amend a pending application based on the drawings included with the application. The *Olson* court found that a drawing having dimensions on the order of a few thousandths of an inch could not be scaled off to show that any particular distances or sizes are exactly equal when the specification was completely silent. *Olson*, 101 U.S.P.Q. at 403. Figure 6 of Furuya illustrates a semiconductor device, and it is well known that such devices involve measurements in the millionths of meters. Under *Olson*, the Examiner would have to rely on the underlying text document of Furuya in order to support his distance assertions with respect to Figure 6 of Furuya. However, without a translation of Furuya, *Olson* forecloses the Examiner's reliance on Figure 6 of Furuya.

Furthermore, it is plainly evident that the Examiner is relying upon the Abstract and only Figure 6 of Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-34, without considering the teachings of the underlying text of Furuya. "Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are

prior art.” MPEP § 706.02 (citing *Ex parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)). It is incumbent upon the Examiner to obtain a translation of Furuya so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. See MPEP § 706.02. The record is also not clear whether the Examiner is relying only upon the Abstract for Furuya or other text in the disclosure of Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32. MPEP § 706.02 states in unambiguous language that the full text document might “include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.” The Examiner cannot simply use the Abstract and Figure 6 of Furuya to reject claims 1, 3, 8, 10, 12, 21-23 and 25-34 without first making a determination that the disclosure of Furuya does not teach away from the claimed invention.

Thus, since the Examiner is improperly relying on the Abstract and Figure 6 of Furuya to reject the claimed resistive relationship between the recited elements, Applicant submits that the “all limitations” prong of a *prima facie* case of obviousness has not been satisfied as required by *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Applicant submits that independent claims 1, 21, 33 and 34 are allowable over Furuya, and Applicant further submits that claims 3, 8, 10, 12, 22, 23 and 25-32 are allowable as well, at least by virtue of their dependency from claims 1 and 21, respectively.

Since *Hockerson-Halberstad* and *Wright* foreclose the Examiner from relying upon Figure 6 of Furuya, motivation to modify Figure 6 of Furuya with a MOS capacitor is lacking as well. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) and *In re Zurko*, 258 F.3d 1379, 1386

(Fed. Cir. 2001) require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to modify Furuya with a MOS capacitor. Here, motivation is completely lacking since Furuya cannot be properly relied upon to support the obviousness rejection (*See* above discussion with respect to the “all limitations” prong of a *prima facie* case of obviousness). Without a reference to modify, the motivation prong of a *prima facie* case of obviousness cannot be fulfilled, as required by *In re Dembiczak* and *In re Zurko*.

Thus, since the motivation prong of a *prima facie* case of obviousness has not been satisfied, Applicant submits that independent claims 1, 21, 33 and 34 are allowable over Furuya, and Applicant further submits that claims 3, 8, 10, 12, 22, 23 and 25-32 are allowable as well, at least by virtue of their dependency from claims 1 and 21, respectively.

Independent claims 33 and 34 have additional grounds for allowance. While the Examiner has rejected claims 33 and 34 over Furuya, there is no disclosure in Furuya of protecting a semiconductor device from electrostatic breakdown due to discharge of electric charge according to a charged device model. The Examiner has failed to address these recitations of claims 33 and 34 anywhere in the December 10, 2004 Non-Final Office Action. Applicant submits that claims 33 and 34 are allowable, in that Furuya does not teach or suggest the claimed resistive relationship between the recited elements, nor does Furuya teach or suggest the charged device model.

3. Claims 9 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya in view of Merritt (U.S. Patent No. 4,786,956). Applicant traverses the rejection of claims 9 and 24 for at least the reasons set forth below.

The Examiner combines Merritt with Furuya in an attempt to overcome the deficiencies of Furuya with respect to the power source conversion circuit recited in claims 9 and 24. Claim 9 includes all the recitations of claim 1 by virtue of its dependency, and claim 24 includes all of the recitations of claim 21 by virtue of its dependency.

The Examiner has failed to cite any passage in Merritt that teaches or suggests the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in independent claims 1 and 21, and included in claims 9 and 24 via dependency. For the same reasons as discussed above with respect to claims 1, 3, 8, 10, 12, 21-23 and 25-32, the combination of Furuya and Merritt fails to teach or suggest the claimed resistive relationship. Applicant submits that the “all limitations” prong of a *prima facie* case of obviousness has not been satisfied, as required by *In re Vaeck*.

Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness as required by *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). The Examiner has not made any findings on the record, as required by *Dembiczak*, as to why one of ordinary skill in the art would be motivated to combine Furuya and Merritt, especially when Merritt lacks any teaching whatsoever with respect to the claimed resistive relationship and *Hockerson-Halberstad* precludes the use of Figure 6 of Furuya. Applicant submits that the motivation prong of a *prima facie* case of obviousness has not been satisfied.



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Thus, since the combination of Furuya and Merritt fail to meet the “all limitations” and motivation prongs of *prima facie* case of obviousness, Applicant submits that claims 9 and 24 are allowable over the combination of Furuya and Merritt.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

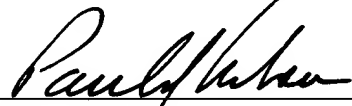
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**23373**

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